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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,157	09/11/2003	Howard Andrew Gutowitz	2003,001/TS	2156
21909	7590	02/27/2009		
CARR LLP 670 FOUNDERS SQUARE 900 JACKSON STREET DALLAS, TX 75202			EXAMINER NGUYEN, TANH Q	
			ART UNIT 2182	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	10/605,157	GUTOWITZ, HOWARD ANDREW	
	Examiner	Art Unit	
	TANH Q. NGUYEN	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-6,12,13 and 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,3,7-11 and 14-19 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

*Election/Restrictions*

1. Newly submitted claim 25 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1, 3, 7-11, 14-15, 17-19, drawn to a text-entry system, classified in class 341, subclass 28. Claim 16, drawn to a method for constructing trigger sequences for a text-entry system, classified in class 341, subclass 28. Claim 25, drawn to a text-entry system, classified in class 341, subclass 28.

Claims 1, 3, 7-11, 14-15, 17-19 are directed to a subcombination of a text-entry system (Invention I) that includes printable symbols comprising pre-conversion symbols, post-conversion symbols and non-conversion symbols; a display to display the printable symbols; a first mechanism to display the printable symbols; a second mechanism to recognize, upon input of a symbol-input-end symbol, elements of a set of trigger sequences of keystrokes and thereby trigger conversion of a pre-conversion symbol or a pre-conversion sequence displayed on the display to a post-conversion sequence comprising a post-conversion symbol – among others.

Claim 16 is directed to a method for constructing trigger sequences for a text-entry system (Invention II) that includes selecting a set of printable symbols from a set consisting of pre-conversion symbols, post-conversion symbols, and non-conversion symbols; selecting a set of sample text sequences; for each member of said set of selected sample text sequences, determining a corresponding keystroke sequence which causes said text-entry system to enter a selected sample text sequence, said corresponding keystroke characterized in that it does not contain a keystroke on a

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conversion key, said conversion key characterized as converting a subset of displayed pre-conversion symbols to a post-conversion symbol, without additionally causing display of further printable symbols where said further printable symbols are selected from the set consisting of pre-conversion symbols and non-conversion symbols – among others.

Claim 25 is directed to a subcombination of a text-entry system (Invention III) that includes pre-conversion symbols, post-conversion symbols, and symbol-input-end symbols; a display to display printable ones of the symbols; a first mechanism to display the pre-conversion symbols; a second mechanism to recognize trigger sequences and thereby trigger conversion of a plurality of pre-conversion symbols displayed by the first mechanism to a plurality of post-conversion symbols, where said second keystroke is on a key having a pre-conversion symbol assigned to it, also immediately causing display of a pre-conversion symbol assigned to said key for later possible input and inclusion in a subsequent sequence of pre-conversion symbols – among others.

2. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope, are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d)

In the instant case, the subcombination of invention I has separate utility such as a text-entry system that includes printable symbols comprising pre-conversion symbols, post-conversion symbols and non-conversion symbols; a display to display the printable symbols; a first mechanism to display the printable symbols; a second mechanism to

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recognize, upon input of a symbol-input-end symbol, elements of a set of trigger sequences of keystrokes and thereby trigger conversion of a pre-conversion symbol or a pre-conversion sequence displayed on the display to a post-conversion sequence comprising a post-conversion symbol – among others.

In addition, the subcombination of Invention III has separate utility such as a text-entry system that includes pre-conversion symbols, post-conversion symbols, and symbol-input-end symbols; a display to display printable ones of the symbols; a first mechanism to display the pre-conversion symbols; a second mechanism to recognize trigger sequences and thereby trigger conversion of a plurality of pre-conversion symbols displayed by the first mechanism to a plurality of post-conversion symbols, where said second keystroke is on a key having a pre-conversion symbol assigned to it, also immediately causing display of a pre-conversion symbol assigned to said key for later possible input and inclusion in a subsequent sequence of pre-conversion symbols – among others.

Where election of a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case the text-entry system of Invention III can be used to practice a method that is materially different from the method of Invention II, i.e. a method that does not require selecting a set of printable symbols from a set consisting of pre-conversion symbols, post-conversion symbols, and non-conversion symbols; selecting a set of sample text sequences; for each member of said set of selected sample text sequences, determining a corresponding keystroke sequence which causes said text-entry system to enter a selected sample text sequence, said corresponding keystroke characterized in that it does not contain a keystroke on a conversion key, said conversion key characterized as converting a subset of displayed pre-conversion symbols to a post-conversion symbol, without additionally causing display of further printable symbols where said further printable symbols are selected from the set consisting of pre-conversion symbols and non-conversion symbols – among others.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 25 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. Restriction to one of the inventions I and II is also required under 35 U.S.C. 121, because Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case In this case the text-entry system of Invention I can be used to practice a method that is materially different from the method of Invention II, i.e. a method that does not require selecting a set of printable symbols from a set consisting of pre-conversion symbols, post-conversion symbols, and non-conversion symbols; selecting a set of sample text sequences; for each member of said set of selected sample text sequences, determining a corresponding keystroke sequence which causes said text-entry system to enter a selected sample text sequence, said corresponding keystroke characterized in that it does not contain a keystroke on a conversion key, said conversion key characterized as converting a subset of displayed pre-conversion symbols to a post-conversion symbol, without additionally causing display of further printable symbols where said further printable symbols are selected from the set consisting of pre-conversion symbols and non-conversion symbols – among others.

6. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

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and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement must include (i) an election of a invention to be examined to be complete (i.e. election of Invention I – claims 1, 3, 7-11, 14-15, 17-19; or Invention II – claim 16) even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time



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of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Notes: In the interview dated March 18, 2008, applicant indicates that applicant intends to claim the trigger sequence illustrated in FIG. 13 of applicant's disclosure. The invention however was not previously claimed in a way which particularly points out and distinctively defines the metes and bounds of the subject matter illustrated by FIG. 13 of applicant's disclosure.

The examiner therefore strongly suggests that applicant maps each limitation of the elected independent claim to specific teachings in the disclosure (preferably by column, line numbers and/or labels and drawings of US publication 2005/0060448 – by Gutowitz) to avoid unnecessary 112 rejections, help the examiner determine the scope of the claims and further the prosecution. The examiner notes that when an applicant maps out the limitations of a claim, 112 rejections are less likely. Note that the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 USC 112, second paragraph, as indefinite - if a claim is amenable to two or more plausible claim constructions.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANH Q. NGUYEN whose telephone number is (571)272-4154. The examiner can normally be reached on M-F (9:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TARIQ HAFIZ can be reached on (571)272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TANH Q. NGUYEN/  
Primary Examiner, Art Unit 2182

TQN: February 26, 2009